

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Invention I (claims 1, 2, 19 and 20) in the reply filed on 9/12/08 is acknowledged. However, upon further review of elected claims 1-2 and 19-20. The examiner noticed that only claims 1-2 are directed to an elected invention I because claims 19-20 directly depend on nonelected invention III. Thus, claims 19-20 along with claims 3-8, 14-18, 21, 27-31, 34-36, 39, 47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Inventions II-VIII, there being no allowable generic or linking claim. Election was made on 9/12/08.

An Office action on the merits of claims 1, 2 as follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"is performed"(claims 1, and 2, lines 2-4) not positive method limitation.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 as best understood is rejected under 35 U.S.C. 102(b) as being anticipated by GB 2214520 to Richard M. Ellis.

Richard M. Ellis. Discloses the substantially method as claimed by the present comprising electroplating an electrically conductive substrate 2 wherein the electroplating is performed intermittently using said substrate surface as cathode and a plating metal as anode at a constant voltage between said anode and said cathode (see Figs. 1-6, in light of the discussion at page 6, bottom paragraph).

6. Claim 1 as best understood is rejected under 35 U.S.C. 102(b) as being anticipated by Nidola et al (6019878).

Nidola et al anticipated claim 1 (refer to abstract and the discussed col. 24, lines 8-18)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claim 2 as best understood is rejected under 35 U.S.C. 103(a) as being unpatentable over Richard M. Ellis

Regarding where repeating application of a voltage between a cathode and an anode and interruption of said application alternately with a voltage time/interruption time ratio of 0.01 to 100, a voltage time of not longer than 10 seconds and an interruption time of not less than 1×10^{-12} seconds. It would have been an obvious matter of design choice to incorporate the above electrode plating voltage versus time ratio requirements since applicant has not disclosed that such claimed features are critical, patentably distinguishing features and it appears that the invention would perform equally well with the voltage and time ratio as taught by the prior art reference (see charts as indicated in Figs 1-4 of the reference and 5).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (571) 272-4569. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mt

10/14/08

/Minh Trinh/
Primary Examiner, Art Unit 3729